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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,014	07/05/2001	Kenji Mameda	0033-0736P	9296

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EXAMINER

SHEPARD, JUSTIN E

ART UNIT	PAPER NUMBER
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2623

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	01/05/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 01/05/2007.

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mailroom@bskb.com

Office Action Summary	Application No.	Applicant(s)	
	09/898,014	MAMEDA, KENJI	
	Examiner	Art Unit	
	Justin E. Shepard	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 11/1/06 have been fully considered but they are not persuasive.

Pages 6 and 7:

The applicant argues that the external apparatus and communication unit are a remote controller and the IR communication port on the broadcast receiver. While the applicant's drawings do suggest this, the claim language does not clearly disclose this. The interpretation of the communication unit being the headend and the external apparatus being the STB is a valid one. The rejection stands.

Claim Objections

Claim 10 is objected to because of the following informalities: The final two paragraphs are worded poorly. It is not clear when the system "transmits the extracted button data," where this data goes. Also, is the remote (read external apparatus) creating an email and transmitting it somewhere? If yes, where and how is this transmitted. The claim will be rejected as it is interpreted.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Portuesi.

Referring to claim 8, Portuesi discloses a separation unit separating video data, video associated data, and button data linked with the video associated data from broadcast wave (fig. 5, element 68; column 9, lines 35-58; column 6, lines 30-42);

a memory that accumulates the separated button data (figure 3, box 30; column 6, lines 25-30);

a display unit displaying the video separated by said separation unit (display window 28, Figure 4; hotspot 40, Figure 4);

a communication unit receiving a command from an external apparatus requesting for the video associated data, and transmitting the video associated data to the external apparatus to be displayed on the external apparatus (fig. 5, element 52 transmits information that element 56 requests; Element 56 then displays the information on element 70).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Portuesi in view of Blackketter.

Referring to claim 9, Portuesi discloses a still picture production unit producing still picture from the video data, wherein said communication unit transmits button data, and the still picture produced by said still picture production unit to the external apparatus to be displayed on the external apparatus (fig. 5, element 52 transmits information that element 56 requests; Element 56 then displays the information on element 70).

Portuesi does not disclose a unit wherein a button is retrieved from the memory among the accumulated button data.

Blackketter discloses a unit wherein a button is retrieved from the memory among the accumulated button data (column 8, lines 38-45 and 49-53).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the retrieving the trigger from memory, as taught by Blackketter, in the unit disclosed by Portuesi. The motivation would have been to enable the triggers to be sent during low bandwidth periods.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Portuesi in view of Vertelney.

Referring to claim 10, Portuesi discloses a broadcast receiver apparatus, comprising:

a separation unit separating (figure 5, part 68), from a broadcast wave (figure 5, part 54), video (figure 5, part 70), video associated data, and button data linked with the video associated data (figure 5, part 72);

a memory that accumulates the separated button data (column 6, lines 25-30);

a display unit displaying the video separated by said separation unit (figure 5, part 70);

a first communication unit (figure 5, part 56), upon receiving an externally applied command (figure 5, part 62) from an external apparatus (figure 5, part 52) provided separately from the broadcast receiver apparatus and operated by a user, extracts the button data from the memory (column 9, lines 35-58).

Portuesi does not disclose a system that transmits the extracted button data, and receiving an electronic mail from the external apparatus, the external apparatus having a mail production unit for producing the electronic mail; and

a second communication unit transmitting the electronic mail received by said first communication unit.

Vertelney discloses a system that transmits the extracted button data, and receiving an electronic mail from the external apparatus, the external apparatus having a mail production unit for producing the electronic mail; and

a second communication unit transmitting the electronic mail received by said first communication unit (column 14, lines 28-34).

At the time it would have been obvious for one of ordinary skill in the art to add the URL emailing taught by Vertelney to the system disclosed by Portuesi. The

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motivation would have been to enable the sharing of information without transferring a lot of data, by just sending the URL.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Portuesi in view of Vertelney as applied to the claims above, and further in view of Lortz.

Referring to claim 11, Portuesi and Vertelney do not disclose a broadcast receiver apparatus according to claim 10, further comprising: a still picture production unit producing a still picture from the video separated by said separation unit, wherein said first communication unit transmits the button data included in the data separated by said separation unit and the still picture produced by said still picture production unit to the external apparatus.

Lortz discloses a broadcast receiver apparatus according to claim 10, further comprising: a still picture production unit producing a still picture from the video separated by said separation unit, wherein said first communication unit transmits the button data included in the data separated by said separation unit and the still picture produced by said still picture production unit to the external apparatus (column 2, lines 15-20).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the still image processing taught by Lortz to the system disclosed by Portuesi and Vertelney. The motivation would have been that pausing the television signal would enable the user to click on the link without worrying about missing the television program.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bendinelli in view of Portuesi.

Referring to claim 12, Bendinelli discloses a remote controller, comprising:

a communication unit (figure 4, parts 54 and 36) receiving data and an image from an external apparatus (figure 4, part 52), the external apparatus being provided independently from the remote controller and having a separation unit separating, from a broadcast wave, video as a source of the image, video associated data, and button data linked with the video associated data (figure 2);

a display unit displaying the image received by said communication unit and displaying a button on said image based on the button data (figure 4, parts 38 and 56);

a select unit selecting a button displayed by said display unit, said display unit displaying the video associated data corresponding to the button selected by said select unit (column 4, lines 53-58).

Bendinelli does not disclose a system with a memory that accumulates the separated button data; and a button data retrieval unit retrieving button data associated with the button selected by the select unit from the memory among the accumulated button data.

Portuesi discloses a system with a memory that accumulates the separated button data (figure 3, box 30; column 6, lines 25-30); and a button data retrieval unit retrieving button data associated with the button selected by the select unit from the memory among the accumulated button data (column 9, lines 35-58).

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At the time of the invention it would have been obvious for one of ordinary skill in the art to add the button memory taught by Portuesi to the system disclosed by Bendinelli. The motivation would have been to enable the user to review the URLs after they were displayed so as they would not need to interrupt their television viewing.

Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bendinelli in view of Portuesi in view of Vertelney.

Referring to claim 13, Bendinelli discloses a remote controller, comprising:

- a communication unit (figure 4, parts 54 and 36) receiving data and an image from an external apparatus (figure 4, part 52), the external apparatus being provided independently from the remote controller and having a separation unit separating, from a broadcast wave, video as a source of the image, video associated data, and button data linked with the video associated data (figure 2);

- a display unit displaying the image received by said communication unit and displaying a button on said image based on the button data (figure 4, parts 38 and 56);

- a select unit selecting a button displayed by said display unit, said display unit displaying the video associated data corresponding to the button selected by said select unit (column 4, lines 53-58).

Bendinelli does not disclose a system with a memory that accumulates the separated button data; and a button data retrieval unit retrieving button data associated with the button selected by the select unit from the memory among the accumulated button data.

Portuesi discloses a system with a memory that accumulates the separated button data (figure 3, box 30; column 6, lines 25-30); and a button data retrieval unit retrieving button data associated with the button selected by the select unit from the memory among the accumulated button data (column 9, lines 35-58).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the button memory taught by Portuesi to the system disclosed by Bendinelli. The motivation would have been to enable the user to review the URLs after they were displayed so as they would not need to interrupt their television viewing.

Bendinelli and Portuesi do not disclose a system with a mail production unit referring to button data corresponding to the button data selected by said select unit, and producing said electronic mail.

Vertelney discloses a system with a mail production unit referring to button data corresponding to the button data selected by said select unit, and producing said electronic mail (column 14, lines 28-34).

At the time it would have been obvious for one of ordinary skill in the art to add the URL emailing taught by Vertelney to the system disclosed by Bendinelli and Portuesi. The motivation would have been to enable the sharing of information without transferring a lot of data, by just sending the URL.

Referring to claim 14, Bendinelli and Portuesi do not disclose a remote controller according to claim 13, wherein said mail production unit produces said electronic mail

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using a template included in button data corresponding to the button selected by said select unit.

Vertelney discloses a remote controller according to claim 13, wherein said mail production unit produces said electronic mail using a template included in button data corresponding to the button selected by said select unit (figure 6).

At the time of the invention it would have been obvious for one of ordinary skill in the art to include the template taught by Vertelney to the system disclosed by Bendinelli and Portuesi. The motivation would have been that creating a system wide email template makes the system easier to use by creating a unified presentation of information.

Referring to claim 15, Bendinelli and Portuesi do not disclose a remote controller according to claim 13, wherein said mail production unit produces said electronic mail using a mail address included in button data corresponding to the button selected by said select unit.

Vertelney discloses a remote controller according to claim 13, wherein said mail production unit produces said electronic mail using a mail address included in button data corresponding to the button selected by said select unit (figure 6; column 12, lines 43-45).

At the time of the invention it would have been obvious for one of ordinary skill in the art to include the mail address taught by Vertelney to the system disclosed by

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Bendinelli and Portuesi: The motivation would have been that sending the address in the message makes it easier for the end user to use.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bendinelli, Portuesi, Vertelney and as applied to claim 13 above, and further in view of Morrison.

Referring to claim 16, Bendinelli, Portuesi, Vertelney do not disclose a remote controller according to claim 13, further comprising: a user information managing unit managing user information, wherein said mail production unit produces said electronic mail based on user information under control of said user information managing unit.

Morrison discloses a remote controller according to claim 13, further comprising: a user information managing unit managing user information, wherein said mail production unit produces said electronic mail based on user information under control of said user information managing unit (figure 5).

At the time of the invention it would have been obvious for one of ordinary skill in the art to include the address book taught by Morrison to the system disclosed by Bendinelli, Portuesi, and Vertelney. The motivation would have been that providing a list of contacts makes it easier for the end user to use by not requiring the user to remember the information.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

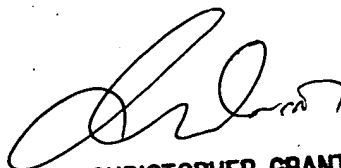
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin E. Shepard whose telephone number is (571) 272-5967. The examiner can normally be reached on 7:30-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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